

REMARKS/ARGUMENTS

This Amendment and the following remarks are intended to fully respond to the Office Action mailed August 8, 2006. In that Office Action, claims 1-17 were examined, and all claims were rejected. More particularly, claims 1-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jeffords et al. (USPN 6,510,478), in view of Brealey et al. (USPN 6,026,401); and claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Jeffords et al. in view of Brealey, in further view of Applicant's admitted prior art. Reconsideration of these rejections, as they might apply to the original and amended claims in view of these remarks, is respectfully requested.

In this Response, claims 1, 3, 4, 8, and 11 have been amended. No claims have been canceled or added. Therefore, claims 1-17 remain present for examination.

Interview Summary

The undersigned thanks Examiner Boutah for the interview conducted on September 22, 2006. The undersigned and Examiner Boutah discussed the proposed claim amendment to claim 1, and the Jeffords reference. The undersigned argued that Jeffords does not teach or suggest modifying a lock property as claimed in the currently pending claims. Additionally, Examiner Boutah indicated that the proposed claim amendment may make claim 1 allowable over the cited art. However, no agreement was reached on allowance of any claims.

Claim Amendments

Claims 1, 3, and 4 have been amended to change the term "lock" to "lock object." Moreover, claims 1, 8, and 11 have been amended to include language that the Applicant believes is inherent in the previously pending claims, namely that modifying a property of a lock object occurs without unlocking the resource associated with the lock object. Support for these amendments can be found at least on page 16, lines 1-8. These amendments are made for purposes of expediting prosecution of the present application. Applicant maintains that the previously pending claims are patentable over the references cited by the Examiner for the same reasons as are described below.

Claim Rejections – 35 U.S.C. § 103

Claims 1-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jeffords et al. (USPN 6,510,478) hereinafter “Jeffords,” in view of Brealey et al. (USPN 6,026,401) hereinafter “Brealey.” Applicant respectfully traverses the rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Manual of Patent Examining Procedure* (MPEP) § 706.02(j) (citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). The Applicant respectfully submits that the Examiner has not met the burden of establishing a *prima facie* case of obviousness, because neither Jeffords nor Brealey disclose all the elements of the currently pending claims and the Examiner has not cited to any other references that compensate for this deficiency. Additionally, the Applicant submits that the Examiner has not adequately established that someone of ordinary skill in the art would be motivated to combine Jeffords and Brealey.

Applicant points out that the Examiner cites to the combination of Jeffords and Brealey to reject the claims. The Examiner relies on Brealey as disclosing the feature of modifying the properties of a lock object, as generally recited in the claims. *See Final Office Action* (8/8/06), page 3. Specifically, the Examiner states that “[t]he construction and destruction of the lock object is interpreted as modifying [sic] lock property as claimed.” *Final Office Action* (8/8/06), page 9. The Applicant kindly submits that the Examiner has interpreted the claims unreasonably broad. Someone of ordinary skill in the art would not equate the destruction of an object with changing a property of an object, particularly in light of the specification. As described in detail below, the Examiner’s interpretation ignores the language in the specification, and consequently is not proper based on legal precedent.

Applicant points out that the Court of Appeals for the Federal Circuit (CAFC) has consistently reinforced the importance of the specification in interpreting claim language. The CAFC has stated that “[t]he claims, of course, do not stand alone. Rather, they are part of ‘a fully

integrated written instrument,’ consisting principally of a specification that concludes with the claims. For that reason, claims ‘must be read in view of the specification, of which they are a part.’ As we stated in *Vitronics*, the specification ‘is always highly relevant to the claim construction analysis.’ *Phillips v. AWH Corporation*, 415 F.3d 1303, 75 U.S.P.Q.2D 1321 (Fed. Cir. 2005) (citations omitted). Indeed, even in the absence of an explicit definition, the specification may provide guidance to interpreting claim terms, “[w]hile it is true, of course, that ‘the claims define the scope of the right to exclude’ and that ‘the claim construction inquiry, therefore, begins and ends in all cases with the actual words of the claim,’ the written description can provide guidance as to the meaning of the claims, thereby dictating the manner in which the claims are to be construed, **even if the guidance is not provided in explicit definitional format.**” *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, 242 F.3d 1337, 1344, 58 USPQ2d 1059 (Fed. Cir. 2001) (emphasis added).

In its recent opinion, *Phillips v. AWH Corporation*, 415 F.3d 1303, 75 U.S.P.Q.2D 1321 (Fed. Cir. 2005), decided *en banc*, the CAFC emphasized the importance of the specification for interpreting claim terms. Although the case focused on the reliance of dictionaries vs. the specification in interpreting claim terms, the court emphasized the importance of the specification stating that “**usually, it is dispositive; it is the single best guide to the meaning of a disputed term.**” *Phillips v. AWH Corporation*, 415 F.3d 1303, 75 U.S.P.Q.2D 1321 (Fed. Cir. 2005) (citations omitted) (emphasis added). The court went on to hold that the specification provides a guide to determine how a patentee uses and defines claim terms. The court stated that “[t]he risk of systematic overbreadth is greatly reduced if the court [or Examiner] instead focuses at the outset on how the patentee used the claim term in the claims, [and] specification” *Id.* at 1322.

In light of this legal authority, the Examiner should look to the specification to understand the meaning of “modifying a property of a lock object,” as used in the claims. Applicant submits that if the Examiner does this, as is required by law, she will realize that the interpretation she has given to the terms extends unreasonably beyond the meaning used in the specification and the claims, and furthermore is inconsistent with the meaning provided in the specification.

Firstly, the Applicant notes that the specification never mentions destroying, deleting, or eliminating a lock object in order to change properties of the lock object. The application illustrates an embodiment of a lock object in FIG. 4. In the corresponding description, the specification states that “properties 402, 406 and 408 may be individually modified without unlocking the resource associated with the lock.” *Specification*, page 16, lines 4-5. Applicant politely submits that this statement is inconsistent with the Examiner’s definition of destroying an object to change a property. If an object were destroyed then the properties 402, 406 and 408 could not be individually modified, without unlocking the resource associated with the lock. Furthermore, independent claims 1, 8, and 11 have been amended to explicitly recite that a property of the lock object is modified (or may be modified) without unlocking the resource.

The specification goes on to describe the “resource identifier property 404, to the extent that it may relate to more than one resource, may also be modified to include other resources, and or remove some resources without changing the existence of the lock on any remaining resource(s). *Specification*, page 16, lines 6-8. Once again, destroying the lock object to modify the resource identifier property would change the existence of the lock on any remaining resources, which is inconsistent with this teaching of the specification.

FIG. 5 illustrates a method 500 of modifying a lock object according to an embodiment. The specification describes the various steps of method 500, none of which include destroying the lock object. As stated on page 23, lines 17-20, “[m]odify lock operation 512 modifies the lock properties according to the request.” The request may be a read, execution, or update access request related to the object. *See Specification*, page 22, lines 1-7. The request does not include destroying the lock object. Finally, the specification also describes the term modify as “changing” (not eliminating, deleting or destroying) a property of a lock object. *See Specification*, page 4, lines 5-9 and page 5, lines 18-20.

For at least these reasons, the Examiner’s interpretation of the claim terms (modifying a lock object to change a property) to include destroying a lock object is improper. The specification includes language that is inconsistent with the Examiner’s interpretation, and nothing in the specification points to a different meaning than “changing” a property of a lock object. Applicant kindly submits that the Examiner has not established a *prima facie* case of

obviousness, because the cited references (Jeffords and Brealey) do not disclose all the elements of claims 1, 8, and 11. Specifically, none of the references disclose modifying a property of a lock object as those terms are used and defined in the specification and claims. The Examiner has not cited to any other reference that compensates for this deficiency. Claims 2-7, 9, 10 and 12-17 depend upon one of claims 1, 8, and 11 and are allowable for at least the same reasons.

Additionally, the Examiner has not provided the requisite motivation to combine Jeffords and Brealey. The Applicant notes that even if the Examiner believes that Jeffords and Brealey disclose all the elements of the claims “a claimed invention would not be obvious without a demonstration of the existence of a motivation to combine those references at the time of the invention.” This requirement prevents a court from labeling as obvious in hindsight a solution that was not obvious to one of ordinary skill at the time of the invention.” *National Steel Car, Ltd. v. Canadian Pacific Railway, Ltd.*, 357 F.3d 1319, 1337, 69 USPQ2d 1641 (Fed. Cir. 2004) (citations omitted) (emphasis added).

The Examiner’s stated motivation for someone of ordinary skill in the art to combine Jeffords and Brealey is “to guard against overlapping modifications between concurrent users, thus decrease the likelihood that data will be in incomprehensible state (abstract).” *Final Office Action* (8/8/06), page 4. As Applicant has stated in previous Office Actions, both Jeffords and Brealey are directed to coordinating the access of objects between a number of processes that may share the objects. Accordingly, each of the references individually would satisfy the stated motivation of guarding against overlapping modifications.

Jeffords teaches a method for coordinating synchronization between processes that share an object “so that the shared object is accessed by one and only one process at a time.” *Jeffords*, col. 1, lines 25-30. Similarly, Brealey “relates to a locking mechanism for common access tool data.” *Brealey*, col. 1, lines 4-6. Brealey teaches exclusive locks that prevent sharing between processes. *See Brealey*, col. 9, lines 29-31. Thus, the motivation provided by the Examiner would not guide someone of ordinary skill in the art to combine the two references, as each individual reference would satisfy the Examiner’s stated motivation. In other words, someone of ordinary skill in the art that wanted to guard against overlapping modifications between

concurrent users would not combine the references, as they would only need one of Jeffords or Brealey to achieve their desired goal.

Moreover, Jeffords' teaching of exclusive access by one process is inconsistent with the method taught by Brealey. Jeffords explicitly states that the "shared object is accessed by one and only one process at a time" (*Jeffords*, col. 1, lines 25-30) and "only the lock owner process can grant control of the lock, and thus control of the shared object, to a requesting process. If the lock owner process determines that the lock is already controlled by another process, the requesting process will have to wait until control of the lock has been returned to the lock owner process." *Id.* at col. 2, lines 55-62. Thus, Jeffords emphasizes the exclusivity of its lock.

In stark contrast to Jeffords, Brealey teaches a method that provides for a shared lock and an exclusive lock. In fact, Brealey seems to indicate that the default position for synchronizing access between processes is to allow shared access to objects. In other words, when a lock is deleted, the previously locked object will be available for shared access. Specifically, Brealey teaches that "by instantiating a delete lock type to remove the instantiation of a shared lock type, shared restricted read/write access to the underlying model object is restored . . . [which] ensures that the object will not be deleted, and allows others to read or modify it" *Brealey* col. 8, lines 49-54. This feature of Brealey is not compatible with the exclusivity emphasized by Jeffords. Indeed, someone of ordinary skill in the art starting from the Jeffords reference would be guided away from combining the teachings of Jeffords with those of Brealey, because Brealey's default shared access state is inconsistent with Jeffords exclusive access teachings.

As described, the Examiner has failed to provide a valid motivation for why someone of ordinary skill in the art would combine Jeffords with Brealey, and further the skilled artisan would be guided away from combining the two references as their teachings are inconsistent. For this additional reason, the Examiner has not established a *prima facie* case of obviousness. Claims 1, 8, and 11 are therefore allowable over the combination of Jeffords and Brealey. Claims 2-7, 9, 10 and 12-17 depend upon one of claims 1, 8, and 11 and are allowable for at least the same reasons.

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Jeffords et al. in view of Brealey, in further view of Applicant's admitted prior art. The Applicant

respectfully submits that because claim 17 depends upon claim 11, it is allowable over the combination of references cited by the Examiner for the same reasons as discussed above with respect to claim 11.

Conclusion

The above amendments and accompanying remarks are believed to be fully responsive to all points raised in the Final Office Action mailed August 8, 2006. Still, the Office Action may contain other arguments and rejections that are not directly addressed herein because those arguments and rejections are rendered moot in light of the preceding arguments in of patentability. Hence, failure to directly address an argument raised, or statement made, in the Office Action should not be taken as an indication that the Applicant believes the argument to have merit. Furthermore, the claims of the present application may include other features, not discussed in the above remarks, which are not shown, taught, or otherwise suggested by the references cited in by the Examiner. Accordingly, the preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability.


It is believed that no fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

In light of the above remarks and amendments, it is believed that the application is now in condition for allowance and such action is respectfully requested. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

Respectfully submitted,

Dated: October 10, 2006




Rene' A. Pereyra, Reg. No. 45,800
MERCHANT & GOULD P.C.
P. O. Box 2903
Minneapolis, MN 55402-0903
(303) 357-1637